

REMARKS

In the last Office Action¹, the Examiner took the following actions:

rejected claims 6 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Gotoh et al. (U.S. Patent No. 5,650,041) ("Gotoh") in view of Chapman (U.S. Patent No. 5,976,769) ("Chapman") and Ha (U.S. Patent No. 6,117,715) ("Ha");

rejected claims 21, 22, 24, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Chapman in view of Ha;

rejected claims 7 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Chapman in view of Ha and further in view of Rioult et al. (U.S. Patent No. 4,322,264) ("Rioult"); and

rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Chapman in view of Ha and further in view of Gotoh.

By this amendment, claims 7, 11-20, 22, and 23 are canceled; and claims 6, 21, and 26 are amended. Claims 6, 8-10, 21, and 24-26 remain under examination.

Claims 6 and 21 are amended to recite a "soluble thin film containing at least one of tungsten oxide or aluminum oxide." Claim 26 is amended to reflect its new dependence based on the cancellation of claim 22.

Applicants respectfully traverse the rejection of claims 6 and 8-10 under 35 U.S.C. § 103(a) as being unpatentable over Gotoh in view of Chapman and Ha. No *prima facie* case of obviousness is established based on the combination of the references.

To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j). The combination of Gotoh, Chapman, and Ha fails to teach or suggest each and every element recited in claim 6.

Claim 6 recites a "soluble thin film containing at least one of tungsten oxide or aluminum oxide." The Examiner acknowledges at pages 7-8 of the Office Action that Chapman and Ha fail to teach the claimed "tungsten oxide" or "aluminum oxide," recited in claim 6. Gotoh also fails to teach a soluble thin film containing either "tungsten oxide" or "aluminum oxide," as recited in claim 6. Accordingly, no *prima facie* case of obviousness is established based on Gotoh, Chapman, and Ha, either alone or in combination, because the references fail to teach or suggest each and every element recited in claim 6.

Claim 8-10 depend from independent claim 6 and are allowable at least due to their dependence. In light of the above remarks, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 6 and 8-10.

Applicants respectfully traverse the rejection of claims 21, 22, 24, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Chapman in view of Ha. Claim 21,

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to

although of different scope, recites similar elements, discussed above, as claim 6. Accordingly, for similar reasons to those discussed above regarding claim 6, no *prima facie* case of obviousness is established with respect to claim 21 based on Chapman and Ha, because the references, either alone or in combination, fail to teach or suggest each every element recited in claim 21.

Claims 24 and 26 depend from independent claim 21 and are allowable at least due to their dependence. Claim 22 is canceled rendering the rejection of this claim moot. Applicants respectfully request the Examiner's reconsideration and the withdrawal of the rejection of pending claims 21, 24, and 26.

Claims 7 and 23 are canceled, rendering the rejection of these claims moot.

Claim 25 depends from claim 21 and, accordingly, incorporates each and every element recited therein. For the above-discussed reasons, no *prima facie* case of obviousness is established with respect to claim 21 based on Chapman and Ha, because the references, either alone or in combination, fail to teach or suggest the claimed "tungsten oxide" and "aluminum oxide," recited in independent claim 21 and required by claim 25. Accordingly, claim 25 is allowable at least due to its dependence from independent claim 21. Applicants respectfully request that that Examiner withdraw the rejection of claim 25.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 6, 8-10, 21, and 24-26 in condition for allowance. Applicants submit that the proposed amendments of claims 6 and 21 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either

automatically subscribe to any statement or characterization in the Office Action.

earlier claimed or inherent within the claimed subject matter. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. Should the Examiner continue to dispute the patentability of the pending claims, it is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections, to place the application in condition for allowance, and to place the application in better form for appeal.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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